



Paper No. 16

MARTIN J. O'DONNELL
CESARI AND MCKENNA, LLP
30 ROWES WHARF
BOSTON, MA 02110

COPY MAILED

AUG 18 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of :
Tzannes, Heller, Stautner, Morrell, and :
Jayashima : **DECISION REFUSING STATUS**
Application No. 08/804,909 : **UNDER 37 CFR 1.47(a)**
Filed: 25 February, 1997 :
Attorney Docket No. 6008/54140 :

This is in response to the petition filed on 7 August, 1997 which is treated as a petition under 37 CFR 1.47(a). The Office apologizes for the delay in responding to the instant petition and regrets any inconvenience to petitioner.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 25 February, 1997, without an executed oath or declaration and naming Michael A. Tzannes, Peter Niels Heller, John P. Stautner, William R. Morrell, and Sriram Jayashima as joint inventors.

Accordingly, on 6 June, 1997, a "Notice To File Missing Parts Of Application" ("Notice To File Missing Parts") was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 7 August, 1997, (certificate of mailing date 4 August, 1997) a petition was filed under 37 CFR 1.47(a). Petitioner additionally submitted the

following:

- (a) a declaration signed by joint inventors Tzannes, Heller, and Morrell on behalf of themselves and by David Hunter, Senior Vice President of Aware, Inc., on behalf of John P. Stautner and Sriram Jayashima;
- (b) letters from counsel of record to joint inventors Stautner and Jayashima;
- (c) the required petition fee;
- (d) a statement that the last known addresses of non-signing joint inventors Stautner and Jayashima are the addresses listed on the letters referenced at (b) above, and
- (e) the required surcharge for late filing.

The petition states that the letters identified above were sent to joint inventors Jayashima and Stautner by Express Mail, on 15 July, 1997, but were both returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2). In regards to item (1), petitioner has not submitted sufficient evidence to prove that diligent efforts have been made to locate the non-signing inventors. A copy of the application papers should be sent to the last known address of each non-signing inventor with a request that he or she sign the declaration for the patent application. The specific dates and times that correspondence was mailed, telephone calls or e-mail searches were made should be included. Petitioner should provide a copy of the envelope showing that the application was returned as undeliverable. Petitioner should also explain what attempts were made to obtain a forwarding address and to locate each inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. through e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached.

In regards to requirement (2), the declaration is not acceptable because all of the signing inventors have not signed the declaration on behalf of themselves and on behalf of the non-signing inventors. A declaration signed by an assignee or other

third party asserting a proprietary interest on behalf of a non-signing inventor is not acceptable for purposes of granting status under 37 CFR 1.47(a). The declaration is acceptable only if all of the signing inventors signed in their respective signature blocks and the signature block of the nonsigning inventor is left blank or all the signing inventors sign a statement saying that they are signing on behalf of the non-signing inventors.

Furthermore, the signature pages for the declarations signed by Tzannes and Heller are on facsimile copies, while the signature page in the declaration signed by Morrell is an original. As such, there is a question whether the entire declaration or only the relevant signature page, was transmitted to each inventor. Petitioner should provide the entire declaration as returned by each inventor or an affidavit based on personal knowledge that the entire declaration was transmitted to each signing inventor prior to signature by the inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.

A handwritten signature in cursive script, appearing to read "Beverly M. Flanagan".

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects